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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE


In re patent application of:) Date: May 2, 2007
Paul Mayer, et al.) Attorney Docket No.: F-741
Serial No.: 10/675,347) Customer No.: 00919
Filed: September 30, 2003) Group Art Unit: 3628
Confirmation No.: 5780) Examiner: Nelson, F. A.

PRE-APPEAL BRIEF CONFERENCE REQUEST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request this pre-appeal review to consider the Examiner's rejections of claims 1-15 in a Final Office Action dated November 3, 2006. A Notice of Appeal is filed herewith.

<u>CERTIFICATE OF FACSIMILE</u>	
I hereby certify that this correspondence is being faxed to the United States Patent and Trademark Office on Fax No.: 571-273-8300	
on <u>May 2, 2007</u> Date of Deposit	<u>Marlene Massop</u> Name
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Argument35 U.S.C. § 102, Anticipation

Claims 8-15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application 2004/0122781 to Barrows, et al. ("Barrows"). Claims 1-7 stand rejected as obvious over Barrows.

Claims 8-15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Barrows. The Barrows reference relates to balancing of funds in postage meters used to print postage onto mail pieces. Thus, the "balancing" described in Barrows is for balancing of financial accounts and determining where the money was spent, and in that way is like balancing a checkbook. (See Barrows paragraphs 10-11).

Rejected independent claim 8 relates to a completely different kind of balancing. The balancing of claim 8 is done for quality control and for controlling the physical disposition of mailpieces created in a manufacturing process. The manufacturing process includes collecting sheets, stuffing them in an envelope, sealing and outputting the envelope. It is desirable to know whether the machine has correctly created all of the mailpieces, and different steps are taken for disposition of the end-product depending on the level of success that is measured during the balancing process.

Barrows is looking at money accounts and reconciling where the money was spent. In contrast, claim 8 is directed to steps to be performed on physical items to ensure that the correct end-product is being delivered. The fact that the money accounts and physical items both happen to be mail-related does not automatically mean they are the same thing. Rather, they are quite different, as can be seen from looking at the steps of claim 8 in comparison to the asserted Barrows reference.

In the Office Action, the Examiner has attempted to match the claim steps with disclosures in the reference. However, if one looks at the text cited by the Examiner for some of the steps, there is nothing there that supports anticipation. Exemplary steps of claim 8 are as follows.

"accounting for a disposition of mail pieces processed in the mail production apparatus;"

Barrows does not include any disclosure of accounting for the disposition of the physical mail pieces. Rather, as seen in the paragraphs cited by the Examiner (paras 11, 14) the Barrows process is looking at postage data for mail pieces. (Para. 11). The postage data in Barrows is gathered from postage meter registers (para 12) and organized into blocks (para 13). This postage meter account review process of Barrows, and asserted by the Examiner, is different than accounting for the disposition of the mail pieces themselves as processed in the mail production apparatus, as recited in claim 8. The accounting process of Barrows does not establish the disposition of the manufactured mailpieces.

"identifying gaps in the subsets where the disposition of one or more mail pieces is unaccounted for;" and "determining that a completed subset does not include identified gaps; and"

As discussed above for the previous step, the disposition of the actual mail piece is not accounted for in Barrows. Rather, the accounting process is being performed on postage fund records.

"submitting the completed subset for delivery prior to finishing balancing for all subsets in the mail run."

In this step, a physical action is taken on the completed subset of mailpieces based on the result of the balancing process. No such physical action is described in Barrows, and particularly not at paragraphs 46 or 121, as cited by the Examiner. The reason for this is that Barrows is directed to reconciling abstract financial accounts, while the present invention is directed to determining the disposition of physical objects, and to taking certain actions on the objects based on that disposition. Paragraphs 46 and 121 of Barrows have no bearing on the claim language in question, and it is hard to see how they are more relevant than any other random text in the Barrows patent.

Thus it is submitted that the rejection of claim 8 should be withdrawn, along with its dependent claims 9-15.

35 U.S.C. § 103(a), Rejection

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as obvious over Barrows. As noted by the Examiner above, Barrows is asserted as prior art under § 102(e). The Examiner has failed to respond to the Applicants previous arguments disqualifying Barrows for purposes of obviousness. Indeed the Examiner has already noted that Barrows and the present application are under common assignment. As such, it is submitted that 35 U.S.C. § 103(c) is applicable, and Barrows may not be asserted to preclude patentability under § 103.

The Examiner has quoted some requirements under 37 C.F.R. 131 relating to filing of an affidavit to disqualify commonly owned references in some special circumstances. However, the means for disqualifying commonly owned references is not limited to that CFR section. Indeed the statutory provisions of 35 U.S.C. § 103(c) says nothing about requiring an affidavit.

The MPEP is also clear on the subject of what constitutes sufficient evidence of common ownership, and that affidavits are not required. It states:

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

MPEP 706.02(I)(2)II – Evidence Required To Establish Common Ownership

Thus to make the disqualification of Barrows more clear, it is hereby represented that the following statement is true:

The present application and the Barrows reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person, Pitney Bowes Inc.

Accordingly, this rejection of claims 1-7 should be withdrawn.

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CONCLUSION

In view of the foregoing, it is respectfully submitted that the rejections of pending claims 1-15 should be withdrawn. If there are any questions on this application, please contact the undersigned attorney.

Respectfully submitted,



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